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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,844	05/07/2002	Robert Benjamin Franks	5897-000009	4210

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/030,844	FRANKS ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on June 11, 2007 and the amended communication filed on June 25, 2007, wherein:

Claims 33-59 are currently pending;

Claims 33-59 have been amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 33-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Berke (US 6,629,092) (hereinafter referred to as Berke).

Referring to Claim 33:

Berke discloses an Internet based system, comprising:

means for presenting a list to a user (Figure 1 (14), interface, (Figure 3 (Step 41) display list), Figures 4 and 5);

means for selecting from the list (Figure 1, col. 5, lines 31-44).

The fact that the list is of goods/services or that the list is in accordance with an official classification of goods and services is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no

new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the fact that the list is of goods/services or that the list is in accordance with an official classification of goods and services, adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claims 34-35, and 41-42:

Berke does not disclose wherein the means for presenting the information comprises a drop down menu or a scroll bar window.

However, the Examiner asserts that it is old and well known to present information via a drop down menu or a scroll bar window.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention use drop down menus or scroll bar windows as a way of presenting information on a website as a means of making it easy for users to

navigate the website and get the information they want. All of the claimed elements were known in the art and one skilled in the art would have used them as a predictable means of presenting information on a website.

The following definitions from OneLook.com computer dictionary indicate that pull-down menus and scrollable list were available at least as early as 1999.

drop-down menu ==>

pull-down menu
<*operating system*> (Or "drop-down menu", "pop-down menu") A menu in a graphical user interface, whose title is normally visible but whose contents are revealed only when the user activates it, normally by pressing the mouse button while the pointer is over the title, whereupon the menu items appear below the title. The user may then select an item from the menu or click elsewhere, in either case the menu contents are hidden again. A menu item is selected either by dragging the mouse from the menu title to the item and releasing or by clicking the title and then the item.
When a pull-down menu appears in the main area of a window, as opposed to the menu bar, it may have a small, downward-pointing triangle to the right.
Compare: scrollable list.
(1999-09-22)

scrollable list
<*operating system*> A list of information in a graphical user interface with a scroll bar, often used to present a list of choices.
(1999-10-03)

Referring to Claims 36-38 and 43:

Berke discloses wherein the selecting means a check box or other way to indicate that the user wanted to be presented with information (col. 5, lines 31-36). Berke does not discloses wherein the selecting means is a highlighting means or an underlining means or an icon.

However, selection by highlighting, underlining or use of an icon is old and well known.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate these well known means into a website as a way of allowing the user to select items. All of the claimed elements were known in the art and one skilled in the art would have used them as a predictable means of presenting information on a website.

Referring to Claims 39, 44 and 48:

Berke discloses method of presenting and selecting goods/services forming part of a trademark application (col. 2, lines 56-61 the database table includes a list of marks and goods; col. 5, lines 22-30 prompts a user to enter search criteria of a trademark (or service mark or trade name) over an Internet based system, the method comprising the steps of:

presenting a list of goods/services to a user (col. 5, lines 22-44); and

the user selecting goods/services from the list (col. 5, lines 22-44; col. 9, lines 39-46);

and entering words in a text box (Figure 3 (Step 28)).

The fact that the list is of goods/services or that the list is in accordance with an official classification of goods and services is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which

impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the fact that the list is of goods/services or that the list is in accordance with an official classification of goods and services, adds

little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As claimed, the fact that the information specified is the country in which a trademark application will be filed in non-functional descriptive data, not functionally related to the steps of the method. Thus, this is further information that is being entered.

The Examiner asserts that the fact that Berke relates to trademarks and the description of goods and services related to trademarks meets the preamble limitations of goods/services forming part of a trademark application, since any registered trademark is the product of an application wherein the mark and goods and services are defined.

Referring to Claim 40:

Berke discloses presenting the list as class heading (col. 5, lines 31-44 list of local vendors or a list of on-line vendors (The Examiner interprets local vendors/on-line vendors as headings and the vendor list as services).

Referring to Claims 45-46:

Berke does not disclose wherein the means for presenting the information comprises a scroll bar window or selecting the information is by highlighting.

However, the Examiner asserts that it is old and well known to present information via a scroll bar window and to select information via highlighting.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention use scroll bar windows as a way of presenting information on a website as a means of making it easy for users to navigate the website and get the information they want. All of the claimed elements were known in the art and one skilled in the art would have used them as a predictable means of presenting information on a website. It would have been obvious to one of ordinary skill in the art to incorporate the well known means of selecting information by highlighting the information. All of the claimed elements were known in the art and one skilled in the art would have used them as a predictable means of presenting information on a website.

Referring to Claim 47:

Berke discloses sorting the goods/services into relevant classes (col. 5, lines 31-44 list of local vendors or a list of on-line vendors (The Examiner interprets the vendor list to be a list of services).

Referring to Claim 49-53:

Berke discloses a user interface, comprising:

a display (Figure 1 (14)).

The Examiner is interpreting the display as being an interface. If applicant is claiming the actual display, then the Examiner asserts that the invention is directed not statutory since an interface is an apparatus and applicant has not provided any further structure. If applicant is claiming the information in the display, this is not statutory since a display is a visual representation of something. Applicant in essence is claiming a webpage. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware. Whatis.com defines "web site" as "a related collection of World Wide Web (WWW) *files* that includes a beginning file called a home page". Whatis.com also defines a "page" on the World Wide Web as "a *file* notated with the Hypertext Markup Language (HTML)" and that it usually contains "text and specifications about where image or other multimedia files are to be placed with the page is displayed". The Microsoft Press Computer Dictionary, 3rd Edition defines a "web page" as "a *document* on the World Wide Web" and further indicates that it consists of "an HTML *file*, with associated files for graphics and scripts, in a particular directory on a particular machine". The Microsoft Dictionary also defines a "web site" as "a group or related HTML *documents and associated files, scripts, and databases* that is served up by an HTTP server on the World Wide Web". Thus, according to common definitions and barring any "special

definition" in an application, web sites or web pages are *files or documents*, not the computer or network hardware that makes available or presents these files. The MPEP gives us guidance on how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material". If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory.

Referring to Claims 54 and 59:

Berke discloses remotely accessible computer system, comprising:

at least one data processor (Figures 1 and 2);

at least one memory (Figures 1 and 2);

at least on interface (Figure 1).

The Examiner asserts that the interface in Berke can be configured to display icons/dialogue boxes, presenting goods and services and receiving instructions.

Referring to Claim 55:

Berke discloses a method for receiving instructions for selection of individual goods/services, comprising;

generating an interactive display with icons (Figures 1 and 2) ;

selecting by activating at least one icon (col. 5, lines 31-44).

The fact that the display contains icons representing a class of goods/services in accordance with an official classification of goods and services

and that the selection is one class of goods and services is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional

and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the fact that the list is of goods/services or that the list is in accordance with an official classification of goods and services, adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claim 56:

Berke discloses generating a box (col. 5, lines 31-44);

receiving instructions by activation of the box (col. 5, lines 31-44).

Referring to Claim 57:

Berke discloses generating a box data entry display for entering information (col. 5, lines 31-44).

Referring to Claim 58:

Berke discloses generating an icon capable of receiving instructions(col. 5, lines 31-44);

receiving instructions by selecting the icon (col. 5, lines 31-44).

Response to Arguments

Applicant's arguments filed 33-59 have been fully considered but they are not persuasive.

The applicant has amended claims 33 and 39 to specify that the predetermined list is in accordance with an official classification of goods and services. The Examiner asserts that this in non-functional descriptive data as set forth above in the rejection.

The Examiner notes that the preamble in claim 33 has been amended from a system configurable to allow a user to file at least one trademark application to a system configurable to allow a user to select a description of goods/services for at least on trademark application. Applicant's arguments with respect to claim 33 have been considered but are moot in view of the new ground(s) of rejection.

The applicant states that the present invention aims to overcome the problem of data input of long and complex goods and services descriptions in an online environment. Applicant states that the difference between Berke and the present application is that the present application is concerned with inputting data to register a trademark in which goods and services can be selected from a pre-stored list of goods and services according to a national or international classification system.

The Examiner asserts that the application is a method and system for displaying and selecting goods and services for a trademark application. It was known at the time of the invention that merely providing an automatic means to

replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.